

REMARKS

Claims 1-17 are pending in the subject application. No claims have been cancelled, withdrawn or amended in the instant Response.

Claims 1-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,928,660 to Kobayashi et al. (the '660 patent) in view of U.S. Pat. No. 5,496,959 to Day (the '959 patent), as evidenced by Webster's Ninth New Collegiate Dictionary and information regarding siloxane polymerization available on the Dow Corning website (i.e., http://www.dowcorning.com/content/sitech/sitechbasics/siloxane_polymerization.asp).

As a preliminary matter, the Applicants respectfully note that the Dow Corning website relied upon by the Examiner was not published until April 27, 2003, as evidenced by Archive.org, which sets forth the date on which this website was published (please see http://web.archive.org/web/*/http://www.dowcorning.com/content/sitech/sitechbasics/siloxane_polymerization.asp). Notably, the subject application has a claim of priority to JP 2002-253540, which was filed on August 30, 2002. As such, the information provided on the Dow Corning website relating to siloxane polymerization is not prior art.

With respect to the '660 patent, the Examiner contends that the '660 patent discloses an aqueous suspension of powdered silicone rubber having a mean particle size in the range of 0.1 to 50 microns. However, the Examiner admits that the '660 patent fails to disclose the N-acyl, N-hydrocarbon taurine claimed in the subject application. To address this deficiency, the Examiner turns to the '959 patent, and contends that the '959 patent discloses N-acyl taurates, and that it would be obvious to incorporate the N-acyl taurates disclosed in

the '959 patent in the aqueous suspension disclosed in the '660 patent. For the reasons set forth below, the Applicants respectfully disagree.

The Examiner is respectfully reminded that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” MPEP § 2143.01 (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). The '660 patent states that “it is necessary to use surfactants that can be utilized as cosmetic raw materials.” (see Column 3, lines 3-4). As such, it is clear that not all surfactants are suitable for use in the composition disclosed by the '660 patent. In fact, the '660 patent enumerates surfactants meeting this requirement that may be utilized. In particular, the '660 patent states that the surfactant is selected from “anionic surfactants such as higher fatty acid soaps, sulfuric acid esters of higher alcohols, N-acylglutarnates and phosphoric acid esters, etc., cationic surfactants, amphoteric surfactants such as betaine type, amino acid type, imidazoline type or lecithin type surfactants, etc., and nonionic surfactants such as polyhydric alcohol ester type and ethylene oxide condensation type surfactants, etc.” (see Column 6, lines 43-50). Notably, the N-acyl, N-hydrocarbon taurine claimed in the subject application is not among the suitable surfactants disclosed, and there is no reason whatsoever for one of skill in the art to predict that the claimed N-acyl, N-hydrocarbon taurine claimed in the subject application can be utilized as a cosmetic raw material, as required for the surfactants of the '660 patent. The Applicants note the distinction between being suitable for use in a cosmetic composition and being suitable as a cosmetic material, which are clearly not one in the same. For

example, water is suitable for use in cosmetic composition, but is clearly not a cosmetic material itself. Based on the requirements set forth in the '660 patent relating to the selection of the surfactant, as well as the extensive list of suitable surfactants disclosed in the '660 patent, there is no reason whatsoever for one of skill in the art to disregard the teachings and requirements of the '660 patent and incorporate a different surfactant, such as an N-acyl, N-hydrocarbon taurine, in the composition disclosed in the '660 patent.

Not only is the composition claimed in the subject application unpredictable to one of skill in the art based on the disclosure and requirements of the '660 patent, but the results obtained in the subject invention are unexpected in view of the disclosures of the '660 and '959 patents. "Evidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut prima facie obviousness." MPEP § 716.02(a). Further, "[e]vidence that a compound is unexpectedly superior in one of a spectrum of common properties . . . can be enough to rebut a prima facie case of obviousness." *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987). Finally, the Applicants respectfully point out that "[n]o set number of examples of superiority is required." (emphasis added) MPEP § 716.02(a).

In particular, the Applicants respectfully submit that the Examples of the subject application support unexpected results of aqueous suspensions comprising the claimed N-acyl-, N-hydrocarbon taurine. Specifically, Table 3 of the subject application sets forth physical properties of Practical Examples 1 and 2 and Comparative Examples 3 and 4. Practical Examples 1 and 2 of the subject application included an N-acyl, N-hydrocarbon

taurine (sodium N-lauroyl, N-methyltaurine and sodium N-myristyl-N-methyltaurine, respectively). Conversely, Comparative Examples 3 and 4 of the subject application included surfactants other than N-acyl, N-hydrocarbon taurine (sodium lauryl sulfate and sodium polyoxyethylene (2) lauryl sulfate, respectively). These anionic surfactants, i.e., sodium lauryl sulfate and sodium polyoxyethylene (2) lauryl sulfate, are well known in the art and are utilized in a plethora of cosmetic compositions, including soaps and shampoos. For example, sodium lauryl sulfate is formed from the esterification of fatty acids. As such, these anionic surfactants are within the surfactants disclosed by the '660 patent that are suitable for use in the composition disclosed therein. In particular, the '660 patent sets forth "anionic surfactants such as fatty acid soaps" as suitable surfactants. (see Column 6, lines 43-44). As set forth in Table 3 in the subject application, Practical Examples 1 and 2, which included the claimed N-acyl, N-hydrocarbon taurine, had excellent physical properties. Conversely, Comparative Examples 3 and 4 of the subject application, which did not include the claimed N-acyl, n-hydrocarbon taurine, but rather other common anionic surfactants, had undesirable physical properties. In particular, the skin care shampoo compositions formed from these four examples of the subject application were used on five panelists. The skin care shampoo compositions formed from Practical Examples 1 and 2 of the subject application had a smooth, slick and moist feel, which is desirable. In contrast, the skin care shampoo compositions formed from Comparative Examples 3 and 4 of the subject application had somewhat insufficient smoothness and a slightly dry feel, which is undesirable. In addition, the skin care shampoo compositions formed from Practical

Examples 1 and 2 of the subject application were uniform after one month of storage. Conversely, the skin care shampoo compositions formed from Comparative Examples 3 and 4 of the subject application had slight creaming in the upper portion. As such, not only do the claimed N-acyl, N-hydrocarbon taurines impart compositions with improved physical properties, but also impart compositions with improved storage stability over time when compared to compositions including conventional surfactants. There is no reason whatsoever for one of skill in the art to expect the excellent physical properties obtained by utilizing N-acyl, N-hydrocarbon taurines in aqueous suspensions, as claimed in the subject application.

In view of the foregoing, the Applicants respectfully submit that claims 1-17 are both novel and non-obvious over the prior art including over the '660 patent and the '959 patent, either individually or in combination. As such, the Applicants submit that the claims are in condition for allowance and respectfully request such allowance.

This response is timely filed; thus, it is believed that no further fees are presently due. However, if necessary, the Commissioner is authorized to charge Deposit Account No. 08-2789 in the name of Howard & Howard Attorneys PLLC for any additional fees or to credit the account for any overpayment.

Respectfully submitted,
HOWARD & HOWARD ATTORNEYS, PLLC

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